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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,401	10/16/2001	Jose L. Francese	6530.0145-01	3026

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/977,401

Applicant(s)

FRANCESE ET AL.

Examiner

Charles A. Marmor, II

Art Unit

3735

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

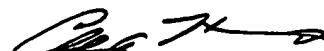
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



Charles A. Marmor, II
SPE
Art Unit: 3735

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive.

Applicant contends that U.S. Patent No. 6,142,980 to Schalk fails to teach a suction adapter having a manifold with a suction port and first and second device ports, where a flexible flow valve has an opening positioned in both a first fluid flow path between the first device port and the second device port and a second flow path between the first device port and the suction port. The Examiner respectfully disagrees. The Examiner notes that the terms "suction port," "first device port" and "second device port" impart no specific structural limitations to the claimed manifold. The terminology merely defines the intended use of the ports, absent any claim limitations positively reciting that the "suction port" is attached to a source of suction, that the "first device port" is attached to a first medical device and that the "second device port" is attached to a second medical device. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In order to meet the limitations of the claim, a prior art reference must only teach a manifold having three ports which are merely capable of performing the claimed intended use. The Examiner submits that Schalk teaches such a structure. Schalk also teaches a flexible flow valve 50 disposed in a fluid flow path ("first flow path") between a first port adjacent reference character 34 ("first device port") and a second port adjacent reference character 64 ("second device port") and in a fluid flow path ("second flow path") between a first port adjacent reference character 34 ("first device port") and a port adjacent reference character 48 ("suction port"). Applicant further argues that Schalk does not disclose a fluid flow path between the opening adjacent the alleged first device port and the alleged second device port. While the Examiner does not contend that Schalk does not expressly disclose a fluid flow path between these two openings, this argument is not persuasive because if the manifold of Schalk is disposed in an orientation as depicted on the cover of the Schalk patent and the valve 76 is held open, fluid flowing from the port adjacent reference character 34 ("first device port") will inherently flow through the port adjacent reference character 64 ("second device port"), thereby forming a fluid flow path. There is nothing in the structure of the manifold of Schalk that would prevent fluid from flowing to the port adjacent reference character 64, particularly given that the valve 76 is disposed on an exterior side of the port adjacent reference character 64 outside of the manifold. The fluid flow valve 50 permits simultaneous fluid flow between the port adjacent reference character 34 and the ports adjacent reference characters 64 and 48, as there is nothing in the interior structure of the manifold of Schalk that prevents such flow. In view of the foregoing, the rejection of claims 1-3, 12, 14, 15 and 17-24 under 35 USC 102(e) as being anticipated by Schalk is maintained.

Applicant further contends that U.S. Patent No. 5,346,477 to Edwards et al. ("Edwards") fails to teach a suction adapter having a manifold with a suction port and first and second device ports, where a flexible flow valve has an opening positioned in both a first fluid flow path between the first device port and the second device port and a second flow path between the first device port and the suction port. The Examiner respectfully disagrees. The Examiner notes that the terms "suction port," "first device port" and "second device port" impart no specific structural limitations to the claimed manifold. The terminology merely defines the intended use of the ports, absent any claim limitations positively reciting that the "suction port" is attached to a source of suction, that the "first device port" is attached to a first medical device and that the "second device port" is attached to a second medical device. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In order to meet the limitations of the claim, a prior art reference must only teach a manifold having three ports which are merely capable of performing the claimed intended use. The Examiner submits that Edwards teaches such a structure. Edwards also teaches a flexible flow valve 86 disposed in a fluid flow path ("first flow path") between a first port adjacent reference character 82 ("first device port") and a second port adjacent reference character 88 ("second device port") and in a fluid flow path ("second flow path") between a first port adjacent reference character 82 ("first device port") and a port adjacent reference character 84 ("suction port"). Applicant further argues that Edwards does not disclose a fluid flow path between the opening adjacent the alleged first device port and the alleged second device port. While the Examiner does not contend that Edwards does not expressly disclose a fluid flow path between these two openings, this argument is not persuasive because if the manifold of Edwards is disposed in an orientation where the flow path between ports 82 and 84 is parallel to the ground with port 88 oriented toward the ground and valve 90 is held open, fluid flowing from the port adjacent reference character 82 ("first device port") will inherently flow through the port adjacent reference character 88 ("second device port"), thereby forming a fluid flow path. There is nothing in the structure of the manifold of Edwards that would prevent fluid from flowing to the port adjacent reference character 88, particularly given that the valve 90 is disposed on an exterior side of the port adjacent reference character 88 outside of the manifold. The fluid flow valve 86 permits simultaneous fluid flow between the port adjacent reference character 82 and the ports adjacent reference characters 88 and 84, as there is nothing in the interior structure of the manifold of Edwards that prevents such flow. In view of the foregoing, the rejection of claims 1-3, 12-15, 17-20, 23 and 24 under 35 USC 102(b) as being anticipated by Edwards and the rejection of claims 4-11 and 16 under 35 USC 103(a) as being unpatentable over Edwards are maintained.